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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,692	02/27/2002	Michael Mazzuca	JJ-10 920-IUS	1511

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EXAMINER

COOLEY, CHARLES E

ART UNIT

PAPER NUMBER

1723


DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A38

Office Action Summary

Application No. 10/083,692	Applicant(s) Mazzuca
Examiner Charles Cooley	Art Unit 1723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3 Feb 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☒ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 Feb 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 3 Feb 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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OFFICE ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3 FEB 2003 have been approved by the Examiner.
2. The drawings remain objected to because of the following informalities:
 - a. the sectional line "A-A" in Figure 5 should be removed.Correction is required.
3. Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must include a print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and *may not be deferred*.

Specification

4. The abstract and title are acceptable.

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Claim Rejections - 35 U.S.C. § 112, second paragraph

5. Claims 3 and 5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, line 3: it appears "separator" should be --separators-- (note claim 5); in line 3, after "outlets" insert --of the separators-- to clarify the wording.

Claim 5, line 3: after "outlets" insert --of the separators-- to clarify the wording.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of Windsor et al and Briggs et al. 170 or Briggs et al. '394 or Carr '238.

Martin discloses an apparatus and method for use as a bypass filter in cleaning fluid (i.e., oil - a well known industrial fluid) comprising a centrifugal separator having a

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casing 10, 95 and a rotatable rotor 20 in the casing; a pump (Col. 5, lines 50-54) between the sump (lubricating tank) and the inlet 62 of the separator for pumping the fluid into the separator to cause the rotor to rotate and clean the fluid; the fluid exiting nozzles 78 and impinging on the casing; the cleansed fluid being returned to the tank (sump - Col. 7, lines 31-33); and a source of compressed gas 111 connected to the casing 10, 95 for controlling the amount of air in the casing. Martin does not disclose the recited control device or the recited g-force range. Windsor et al. discloses an apparatus and method for cleaning lubricants comprising a centrifugal separator 10 having a casing 12 and a rotor 34 in the casing; a pump 18 between the tank 12 and the inlet 22 of the separator; and a control device 91 which functions to monitor the operation of the separator and control the pump 18 and source of compressed air (Col. 4, lines 20-64). Briggs et al. 170 and Briggs et al. '394 each teach that a centrifuge 26 is commonly used for separating lubricant fluid from solids and the centrifuge is operated within the claimed range of claims 1 and 2. Carr '238 teaches that a centrifuge 10 which is used for separating solids and liquids wherein the separated solids are collected on an inner surface of the centrifuge rotor is operated within the claimed range of claims 1 and 2. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the device of Martin with a control device as disclosed by Windsor et al. for the purpose of monitoring and controlling the operation of the centrifuge, including controlling the pump and source of compressed air, and to provide for the automatic cycling of the centrifuge

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(Col. 5, lines 46-47). It would have further been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have operated the centrifuge of Martin within the recited range of g-forces as taught by Briggs et al. 170, Briggs et al. '394, or Carr '238 for the purpose of ensuring the separation of the solids from the liquids and because the operation of centrifuges within the recited g-force range has been shown to be a conventional method of operation in the centrifuging art for separating solid and liquid materials (Briggs et al. 170: Col. 3, line 62 through Col. 4, lines 1-9; Briggs et al. '394: Col. 3, lines 31-46; Carr '238: Col. 1, lines 14-45 and Col. 6, lines 19-40).

Allowable Subject Matter

8. Claims 3 and 5 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

9. Claims 4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Amendment

10. Applicant's arguments filed 3 FEB 2003 have been fully considered but they are not deemed to be persuasive.

With respect to Applicant's arguments that the secondary references to Windsor et al and Briggs et al. 170 or Briggs et al. '394 or Carr '238 cannot be bodily incorporated into the primary reference of Martin, the test for obviousness is not whether the features of the reference may be *bodily incorporated* into the other to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art. *In re Bozek*, 163 USPQ 545 (CCPA 1969); *In re Richman*, 165 USPQ 509 (CCPA 1970); *In re Beckum*, 169 USPQ 47 (CCPA 1971); *In re Sneed*, 218 USPQ 385. The suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all of the references used to show obviousness and instead may be an implied suggestion. *Cable Electric Products., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985); *In re Sernaker*, 217 USPQ 1 (Fed. Cir. 1983); *In re Nilssen*, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). It is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. Rather, the test for combining references is what the combined teachings of the references as a whole would have suggested to those of ordinary skill in the art. *In re Sheckler*, 168 USPQ 716 (CCPA 1971); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971); *In re Young*,

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159 USPQ 725 (CCPA 1968); *Cable Elec.*, 226 USPQ at 886-87. The motivation to combine can arise from the knowledge that the prior art elements will perform their expected functions to achieve their expected results when combined for their common known purpose. *Miles Lab., Inc. v. Shandon Inc.*, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993). In the instant application, the secondary reference to Windsor et al. makes obvious or suggests to one of ordinary skill in the art the provision of providing a centrifuge with a control device for the purpose of monitoring and controlling the operation of the centrifuge, including controlling the pump and source of compressed air, and to provide for the automatic cycling of the centrifuge. The secondary references to Briggs et al. 170, Briggs et al. '394, and Carr '238 each teach that a centrifuge which is commonly used for separating lubricant fluid from solids is operated within the claimed g-force range of claims 1 and 2.

While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any hint or suggestion in a particular reference. *In re Bosek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985).

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With respect to the applied references, the examiner has considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). Additionally, the specific teachings of each reference and the inferences which one skilled in the art would have reasonably been expected to draw from the disclosure has been taken into account. *In re Preda*, 401 F.2d 825, 159 USPQ (CCPA 1968). On the basis of the knowledge and level of skill in the art at the time of applicant's invention, as reflected by the applied references, the examiner concludes that the rejections under 35 USC 103 are well founded.

Applying the test for obviousness set forth in *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), which is what the combined teachings of the references would have suggested to those of ordinary skill in the art, the examiner concludes that one having ordinary skill in the art would have found it prima facie obvious to have provided the device of Martin with a control device as disclosed by Windsor et al. for the purposes outlined above and to have operated the centrifuge of Martin within the recited range of g-forces as taught by Briggs et al. 170, Briggs et al. '394, or Carr '238 for the purposes also outlined above.

With respect to the argument that the prior art must contain something to suggest the desirability of the combination, it is noted that to justify combining reference teachings in support of a rejection under 35 USC 103, it is not necessary that a device shown in one reference be capable of being physically inserted into the device shown in

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the other or that the prior art suggest expressly the changes or possible improvements the applicant has made. It is only necessary that knowledge clearly present in the prior art was applied. *In re Keller*, supra; *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). The examiner has applied only knowledge clearly present in the prior art as evidenced by the prior art in the rejections of the pending claims and the rejections are thus proper.

Accordingly, the control of the pump which feeds liquid to the centrifuge as taught by Windsor et al. is certainly capable of generating the g-force range suggested by the patents to Briggs et al. 170, Briggs et al. '394, or Carr '238. Contrary to Applicant's assertion, the fluids being treated by the prior art devices can reasonably be classified as industrial fluids within the broad scope of the term.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Briggs et al. 170, Briggs et al. '394, and Carr '238 each teach the recited g-force range irrespective of the manner in which the centrifuge is driven. Clearly, in view of these teachings of the g-force range, the pump fed centrifuge of Martin could be operated within said range to obtain satisfactory separation of the materials.

Since the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been prima facie

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obvious at the time the invention was made, to a person having ordinary skill in the art, from the combined teachings of the references, the rejections under 35 USC 103(a) are considered proper.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).


A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. **ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is ☎ (703) 308-0112.

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13. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is ☎ (703) 308-0651.

Dated: 3 March 2003



Charles Cooley
Primary Examiner
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